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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,865	03/18/2004	Philippe Jerome Didier Riviere	88265-7344	5444

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EXAMINER	
PEARSE, ADEPEJU OMOLOLA	
ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/802,865	RIVIERE ET AL.	
	Examiner	Art Unit	
	Adepeju Pearse	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) *17-27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☒ Claim(s) *1,6 and 9* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16, drawn to a frozen dessert, classified in class 426, subclass 660.

II. Claims 17-22, drawn to a process for manufacturing a frozen dessert, classified in class 426, subclass 519.

III. Claims 23-27, drawn to a container for a frozen dessert, classified in class 426, subclass 67.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process and does not require the specifics of homogenizing, heating, cooling etc.

3. Inventions III and I are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus as claimed can be used to make a different product such as aerosols e.g. hair mousse.

4. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as spray paint.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Robert Barrett on 11/29/2005 a provisional election was made without traverse to prosecute the invention of group I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

1. Claims 1, 6 and 9 are objected to because of the following informalities: Claims 1 and 6 recite the phrase "optional fructose". As instantly claimed, it is unclear if fructose is included or not included in the mixture comprising the sweetening agent. The claims contradict by reciting a mixture in which one of it components *fructose* is optional and therefore giving a sweetening agent that is not a mixture. Appropriate correction is required.

2. Claim 9 recites the phrase "optionally one or more fats of ....". As instantly claimed, it is unclear if this phrase is further limiting the fat content. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites the limitation "demineralized whey or demineralized and lactose-free whey" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5 and 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Whelan et al (US Pat. No. 5,084,295). With regard to claim 1, Whelan et al disclose a frozen dessert composition comprising of water, proteins, fat, sweetening agents and stabilizing agents (Col 6 lines 1-8, lines 31-38). The sweetening agents include glucose, fructose, sucrose and mixtures of these sweeteners and comprises from about 10 to about 20% of the product (col 12 lines 5-15), which is within applicant's recited range. The stabilizing agents include microcrystalline cellulose, locust bean gum, etc and they produce smoothness in the textural properties of the product and retard ice crystal growth during storage of the product (col 14 lines 39-55). It is

inherent that the particle size of the stabilizing agent is small enough to act as a nucleating agent because it is well known that microcrystalline particles have very small particle sizes. In addition it is inherent that the water is frozen because it is utilized in a frozen dessert.

3. With regard to claim 2, Whelan et al disclose microcrystalline cellulose as a stabilizing agent. The amount of stabilizer included in the frozen dessert is typically from about 0.05 to about 0.5%, this range is within applicant's recited range (col 14 lines 57-61).

4. With regard to claim 3, Whelan et al disclose that the amount of water present is from about 50 to about 75%, this range encompasses applicant's recited range (col 14 lines 30-32). It is inherent that the water is partially frozen/frozen because it is utilized in a frozen dessert.

5. With regard to claims 4-5, Whelan et al disclose suitable emulsifiers from about 0.05 to about 2% (col 14 lines 11-12) and optional ingredients such as egg yolk from about 1 to 2% of the product (col 15 lines 1-6). These ranges are within applicant's recited range. Stabilizers including carrageenan, alginate, gelatin, carboxymethylcellulose, etc (col 14 lines 48-55) which are well known in the art as thickeners.

6. With regard to claim 9, Whelan et al disclose a fat content from about 2 to about 20% (col 4 line 59). This range encompasses applicant's recited range.

7. With regard to claims 10-11, Whelan et al disclose suitable fats including sunflower oil, coconut oil, safflower oil, olive oil that are all plant derived (col 9 lines 1-10).

8. With regard to claim 12, Whelan et al disclose proteins from about 3 to about 15% (col 11 lines 27-29). This range is within applicant's recited range.

9. With regard to claims 13-14, Whelan et al disclose suitable proteins including, whole milk, skimmed milk, skimmed milk from which a portion of the lactose has been removed,

neutralized acid whey, modified whey, whey protein concentrate etc (col 11 lines 35-50). It is inherent that modified whey encompasses demineralized whey because it has been modified by demineralization.

10. With regard to claim 15, Whelan et al disclose non-dairy based sources of protein such as vegetable e.g. soy protein (col 11 lines 59-61), which is a leguminous plant.

11. With regard to claim 16, Whelan et al disclose other components of the frozen dessert product including flavoring substances (col 13 line 21-24).

12. Claims 1-5 and 9-14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Morley (US Pat. No. 4,427,701). Morley discloses a frozen dessert comprising water, proteins, fat, sweetening agents and stabilizing agents. The sweetening agents include fructose, corn syrup, etc at a range from 22 to 30% (col 6 lines 26-37), which is within applicant's recited range. The stabilizing agents comprise microcrystalline cellulose, locust bean gum, guar gum etc (col 7 lines 30-33). It is inherent that the particle size of the stabilizing agent is small enough to act as a nucleating agent because it is well known that microcrystalline particles have very small particle sizes. In addition it is inherent that the water is frozen because it is utilized in a frozen dessert.

13. With regard to claim 2, Morley discloses microcrystalline cellulose as a stabilizing agent. The amount of stabilizer included in the frozen dessert is typically from about 0.05 to about 1.1%; this range is within applicant's recited range (col 6 line 68, col 7 lines 1-2).

14. With regard to claim 3, Morley discloses that the amount of water present is from about 50 to 60%, this range is within applicant's recited range (col 5 lines 66-67). It is inherent that the water is partially frozen/frozen because it is utilized in a frozen dessert.

15. With regard to claims 4-5, Morley discloses suitable emulsifiers from 0.45 to 0.775% (col 7 lines 39-40) such as mono and di-glycerides. This range is within applicant's recited range. Morley discloses that the stabilizer system employs gelling agent such as gelatin, carrageenan, sodium alginate etc (col 7 lines 22-26) that are well known in the art as thickeners.

16. With regard to claim 9, Morley discloses a fat content from 0 to 5% (col 5 line 15-17). This range is within applicant's recited range.

17. With regard to claims 10-11, Morley discloses suitable fats including butter fat, sunflower oil, coconut oil, safflower oil, olive oil that are all plant derived (col 5 lines 24-37).

18. With regard to claim 12, Morley discloses proteins from 4 to 5.5% (col 5 lines 62-63). This range is within applicant's recited range.

19. With regard to claims 13-14, Morley discloses suitable proteins including, milk, neutralized acid whey, modified whey, whey protein concentrate etc (col 5 lines 50-65). It is inherent that modified whey encompasses demineralized whey because it has been modified by demineralization.

20. With regard to claim 16, Morley discloses other components of the frozen dessert product including flavoring substances (col 6 lines 5-16).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

22. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

23. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

24. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whelan et al (US Pat. No. 5,084,295) in view of Cole et al (US. Pat. No. 4,452,824). With regard to claims 6-7, Whelan disclose et al disclose suitable high nutritive carbohydrate sweeteners such as glucose,

fructose, corn syrups, invert sugar etc (col 12 lines 5-10). In addition Whelan et al disclose that bulking agents such as maltodextrin, gums, starches etc (col 12 lines 40-50) could be added with noncaloric or reduced calorie sweeteners. However, Whelan failed to disclose the amounts of each component in the sweetening mixture. The blending of sweeteners is well known for their art recognized function. It would have been obvious to one of ordinary skill in the art to expect that the amount of sweetener included is an experimental result variable based on sweetness intensity of the particular sweetener and the sweetness effect desired in the product absent any clear and convincing evidence and/or arguments to the contrary.

25. With regard to claim 8, Whelan et al failed to disclose a glycerol content in the frozen dessert product. However, Cole et al teach a soft frozen dessert comprising low molecular weight polyhydric alcohols such as glycerol at a level of 1% to 5%, which encompasses applicant's recited range in order to function as freezing point depressants to impart increased softness to a frozen product (col 2 lines 35-50). It would have been obvious to one of ordinary skill in the art to incorporate glycerol as a freezing point depressant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adepeju Pearse whose telephone number is 571-272-8560. The examiner can normally be reached on Monday through Friday, 8.00am - 4.30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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